

PATENT
Docket No. 395/35

#6
8/8
8/4/00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Gerard M. HOUSEY

Serial No.: 09/510,562

Filing Date: February 22, 2000

For: METHOD FOR SCREENING FOR PROTEIN INHIBITORS AND
ACTIVATORS

Examiner: Saunders, David A.

Art Unit: 1643

Assistant Commissioner for Patents
Washington, D.C. 20231

TERMINAL DISCLAIMER

07/14/2000 BFRISDN 00000002 110500 09510562
110.00 CH 88 10 14:00

Sir:

ICT Pharmaceuticals, Inc., having its principal place of business at 3150 Livernois, Suite 115, Troy, Michigan 48083-5000, represents that it is the owner of the entire right, title, and interest in and to the above-identified application, Serial No. 09/510,562, filed February 22, 2000, for "METHOD FOR SCREENING FOR PROTEIN INHIBITORS AND ACTIVATORS", in the name of Gerard M. HOUSEY, as indicated by assignment filed in the United States Patent and Trademark Office via facsimile on July 12, 2000 (copies of faxed assignment and recordation cover sheet are attached hereto); and is the owner of the entire right, title, and interest in and to U.S. Patent No. 4,980,281 as indicated by assignment duly recorded in the United States Patent and Trademark Office at Reel No. 6714, Frame No. 0328; and is the owner of the entire right, title, and interest in and to U.S. Patent No. 5,266,464 as indicated by assignment filed in the United States Patent and Trademark Office on (copies of assignment and PTO communication evidencing ownership by ICT Pharmaceuticals, Inc. are attached hereto); and is the owner of the entire right, title, and interest in and to U.S. Patent No. 5,688,655 as indicated

by assignment duly recorded in the United States Patent and Trademark Office at Reel No. 6704, Frame No. 0617

ICT Pharmaceuticals, Inc. hereby disclaims, pursuant to 37 C.F.R. § 1.321, the terminal part of the statutory term of any patent granted on the above-identified application, Serial No. 09/510,562, which would extend beyond the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154-156 and 173, as presently shortened by any terminal disclaimer, of U.S. Patent Nos. 4,980,281; 5,266,464; and 5,688,655. ICT Pharmaceuticals, Inc. hereby agrees that any patent so granted on the above-identified application, Serial No. 09/510,562, shall be enforceable only for and during such period that it and U.S. Patent Nos. 4,980,281; 5,266,464; and 5,688,655 are commonly owned. This agreement runs with any patent granted on the above-identified application, Serial No. 09/510,562, and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, ICT Pharmaceuticals, Inc. does not disclaim the terminal part of any patent granted on the above-identified application Ser. No. 09/510,562 prior to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154-156 and 173, of U.S. Patent Nos. 4,980,281; 5,266,464; and 5,688,655, as presently shortened by any terminal disclaimer(s), in the event that any of such U.S. patents expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or in part, is terminally disclaimed under 37 C.F.R. § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term, as presently shortened by any terminal disclaimer.

The Commissioner is hereby authorized to charge the requisite fee, pursuant to 37 C.F.R. § 1.20(d), for filing this terminal disclaimer, or to credit any overpayment to Kenyon and Kenyon's Deposit Account No. 11-0600.

The undersigned is an attorney of record.

I hereby declare that all statements made of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States

Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

KENYON & KENYON

Dated:

July 12, 2000

By:

for *Neil M. McCarthy*
Steven J. Lee

Reg. No. 31,272

Reg. No.

43,435

KENYON & KENYON

1500 K. St. N.W.

Suite 700

Washington, D.C. 20005-1257

Tel: 202-220-4200

Fax: 202-220-4201

Direct: 202-220-4263

FORM PTO-1595

(Rev. 6-93)

OMB No. 0651-0011 (exp. 4/94)

RECORDATION FORM COVER SHEET

U.S. DEPARTMENT OF COMMERCE

Patent and Trademark Office

PATENTS ONLY

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

GERARD M. HOUSEY

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

3. Nature of conveyance:

- ☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Other _____

Execution Date:

2. Name and address of receiving party(ies):

Name: ICT PHARMACEUTICALS, INC.

Internal Address:

Street Address: 3150 Livernois, Suite 115
Troy, Michigan 48063-5000Additional name(s) & address(es) attached? ☐ Yes ☒ No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is:

A. Patent Application No.(s)

09,510,562

B. Patent No.(s)

Additional numbers attached: ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Neil M. McCarthy
Kenyon & Kenyon
1500 K Street, N.W.
Washington, DC 20005

6. Total number of applications and patents involved: 1 1

7. Total fee (37 CFR 3.41).....\$40.00

☐ Enclosed☒ Authorized to be charged to deposit account

8. Deposit account number:

11-0600

(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

9. Statement and signature.

*To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.*Neil M. McCarthy (Reg. #43,435)
Name of Person Signing

Signature

July 12, 2000
Date

Total number of pages comprising cover sheet: 3

OMB No. 0651-0011 (exp. 4/94)

FROM KENYON & KENYON DC

(WED) 7. 12' 00 11:27/ST. 11:26/NO. 4861508254 P 2

ASSIGNMENT

WHEREAS, I, Gerard M. Houscy, citizen of the United States, residing at 28520 Streamwood Lane, Southfield, Michigan 48034, have invented new and useful improvements in the METHOD FOR SCREENING FOR PROTEIN INHIBITORS AND ACTIVATORS, for which I made an application (hereinafter "APPLICATION") for Letters Patent of the United States; said APPLICATION having been given United States Ser. No. 09/510,562, filed February 22, 2000.

WHEREAS, ICT Pharmaceuticals, Inc. (hereinafter "ICT"), organized and existing under and by virtue of the laws of the State of Delaware, having a principal place of business at 3150 Livernois, Suite 115, Troy, Michigan 48083-0500, is desirous of acquiring the entire right, title and interest in and to the APPLICATION and the invention therein described and claimed and any Letters Patent that may be issued upon the APPLICATION or for the improvements therein contained.

NOW, THEREFORE, for and in consideration of the equivalent sum of \$1.00 to me in hand paid, and other good and valuable consideration, the receipt and sufficiency whereof is hereby acknowledged, I have sold, assigned and transferred and do hereby sell, assign and transfer unto ICT, its successors and assigns, the entire right, title and interest in and to the APPLICATION and the invention therein contained, including the right to apply for any Letters Patent in the United States of America and in any and all other applications for Letters Patent on said invention, in whatsoever countries, including all divisionals, renewal, substitute, continuation, continuation-in-part and convention applications based in whole or in part upon said inventions or upon said applications, and any and all Letters Patent that may issue thereon, in the United States of America and foreign countries, and any and all reissues, extensions, renewals, divisions, continuations or continuations-in-part of Letters Patent granted for said inventions or upon said applications, to the full end of the term or terms for which the Letters Patent may be issued, the same to be held and enjoyed by ICT, its successors and assigns, the same as it would have been held and enjoyed by me if this Assignment and sale had not been made; together with all claims for damages by reason of past infringement of said Letters Patent with the right to use for and collect the same for its own use and behalf or for the use and behalf of its heirs, executors, assigns or other legal representative.

FROM KENYON & KENYON DC

(WED) 7. 12' 00 11:28/ST. 11:26/NO. 4861508254 P 3

I hereby retain only the right to be a party to any suit brought on the Letters Patent that may be issued.

And I hereby authorize and request the Commissioner of Patents and Trademarks to issue all such Letters Patent to ICT, its successors and assigns, in accordance with this instrument of Assignment.

I hereby represent and warrant that there are no rights and interests outstanding inconsistent with the rights and interests granted herein and that I will not execute any instruments or grant or transfer any rights or interests inconsistent therewith, and I bind myself, my heirs, executors, administrators and legal representatives, as the case may be, to execute and deliver to ICT, its successors and assigns, any further documents or instruments and do any and all further acts that may be deemed necessary by ICT, its successors and assigns, to transfer the title herein conveyed, or intended so to be and to enable such title to be recorded in the United States.

And I further covenant and agree, in consideration of the premises that I, my executors and administrators, will at any time upon request, communicate to ICT, its successors and assigns, any facts relating to the invention and improvements and the history thereof, known to me or my executors and administrators, and that I will testify as the same in any interference or other litigation when requested so to do by ICT, its successors and assigns.

IN TESTIMONY WHEREOF, I have hereunto set my hand on this 12th day of July, 2000.



Gerard M. Housey

TUE: 7:11'00 14:13/ST. 14:12/NO. 48614741

FORM PTO-1585

RECORDATION FORM COVER SHEET

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

1-31-92

Tab settings -----

PATENTS ONLY

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof

1. Name of conveying party(ies):

Gerard M. Housey

Additional name(s) of conveying parties attached? ☐ Yes ☒ No

3. Nature of conveyance:

☒ Assignment☐ Merger☐ Security Agreement☐ Change of Name☐ Other:Execution date: December 30, 1990

2. Name and address of receiving party(ies)

Name: ICT Pharmaceuticals, Inc.Street Address: 2170 Broadway

Suite 100

City: New York State: New York ZIP: 10024Additional name(s) & address(es) attached? ☐ Yes ☒ No

4. Application numbers or patent numbers:

If this document is being filed together with a new application, the execution date of the application is:

A. Patent Applications

07/392,073, continuation-in-part of
U.S. Patent No. 4,980,281

B. Patent No.(s)

OCT 4 1993

OFFICE OF PETITIONS
AS OF DATEAdditional Numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Kenneth E. Madsen, Esq.
Internal Address: KENYON & KENYONStreet Address: One BroadwayCity: New York State: New York ZIP: 100046. Total number of applications and patents involved: 17. Total fee (37 C.F.R. 3.41) \$ 40.00☐ Enclosed☒ Authorized to be charged to deposit account

8. Deposit account number:

11-0600

(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Kenneth E. Madsen (Reg. No. 20,721)

Name of Person Signing

Signature

Date

Total Number of pages including cover sheet, attachments and document: 5

OMB No. 0651-0011 (exp. 4/94)

Do not detach this portion
Mail documents to be recorded with required cover sheet information to:Commissioner of Patents and Trademarks
Box Assignments
Washington DC 20231

Public burden reporting for this sample cover sheet is estimated to average about 30 minutes per document to be recorded, including time for reviewing the document and gathering the data needed and completing and reviewing the sample cover sheet. Send comments on public burden estimates to the U.S. Patent and Trademark Office, Office of Information Systems, PKC-10004, Washington D.C. 20231, and to the Office of Management and Budget, Paperwork Reduction Project (0605-0011), Washington, D.C. 20503

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OCT 4 1993

OFFICE OF PETITIONS

(TUE) 7.11'00 14:13/ST. 14:12/NO. 48514747 4

A S S I G N M E N T

WHEREAS, I, Gerard M. Housey, citizen of the United States, residing at 100 Haven Avenue, Apt. 7-E, New York, New York 10032, have invented new and useful improvements in the METHOD OF SCREENING FOR PROTEIN INHIBITORS AND ACTIVATORS, for which I made an application for Letters Patent of the United States; said application having been given USSN 154,206 and having issued as U.S. Patent No. 4,980,281 on December 25, 1990.

REC 6714 MAR 329

WHEREAS, ICT PHARMACEUTICALS, INC., (hereinafter "ICT") organized and existing under and by virtue of the laws of ^{State of Delaware} ~~the United States of America~~, having an office at 2170 Broadway, Suite 100, New York, New York 10024, is desirous of acquiring the entire right, title and interest in and to the application and the invention therein described and claimed and any Letters Patent that may be issued upon the application or for the improvements therein contained.

NOW, THEREFORE, for and in consideration of the equivalent sum of \$2,000= to me in hand paid, and other good and valuable consideration, the receipt and sufficiency whereof is hereby acknowledged, I have sold, assigned and transferred and do hereby sell, assign and transfer unto ICT, its successors and assigns, the entire right, title and interest in and to the application and the invention therein contained, including the right to apply for any Letters Patent in the United States of America and in any and all other applications for Letters Patent on said invention, in whatsoever countries, including all divisionals, renewal, substitute, continuation, continuation-in-part and convention applications based in whole or in part upon said inventions or upon said

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application, and any and all Letters Patent that may issue thereon, in the United States of America and foreign countries, and any and all reissues, extensions, renewals, divisions, continuations or continuation-in-part of Letters Patent granted for said inventions or upon said application, to the full end of the term or terms for which the Letters Patent may be issued, the same to be held and enjoyed by ICT, its successors and assigns, the same as it would have been held and enjoyed by me if this Assignment and sale had not been made; together with all claims for damages by reason of past infringement of said Letters Patent with the right to use for and collect the same for its own use and behalf or for the use and behalf of its heirs, executors, assigns or other legal representative.

I hereby retain only the right to be a party to any suit brought on the subject patent(s) by ICT.


And I hereby authorize and request the Commissioner of Patents and Trademarks to issue all such Letters Patent to ICT, its successors and assigns, in accordance with this instrument of Assignment.

I hereby represent and warrant that there are no rights and interests outstanding inconsistent with the rights and interests granted herein and that I will not execute any instruments or grant or transfer any rights or interests inconsistent therewith, and I bind myself, my heirs, executors, administrators and legal representatives, as the case may be, to execute and deliver to ICT, its successors and assigns, any further documents or instruments and do any and all further acts that may be deemed necessary by ICT, its successors and assigns, to transfer the title herein conveyed, or intended so to be and to enable such title ~~to be recorded in the United States.~~

RECEIVED 6714 JAN 330

IN TESTIMONY WHEREOF, I have hereunto set my hand and seal this 30th day of December, 1997. *7*

199x.⁰


Ed M. Housey

[illegible]

REL 67-14, FRANK 331

OCT -4 93

PATENT AND TRADEMARK
OFFICE

FROM (TUE) 7.11'00 14:17/ST. 14:12/NO. 4861417477 P 13



The stamp of the Patent Office herein, may be taken
as acknowledging the receipt, on the date stamped, of

Petition under 37 C.F.R. 3.81

Assignment

Assignment Form Recordation Sheet

Fee: To be charged to Dep. Acct. 11-0500

RECEIVED

Gerard M. Housey

Serial No. 07/392,073

Filed: August 10, 1989

OCT 4 1993

**OFFICE OF PETITIONS
& TRADE**

395/3

10/1/93

KEM:mcw

(TUE) 7:13:00 14:17/ST. 14:12/KC. 48514:74102 14

Petition under 37 C.F.R. 3.81
Assignment
Assignment Form Recordation Sheet
Fee: To be charged to Dep.Acct. 11-0600
Gerard M.

Gerard M. Housey
Serial NO. 07/392,073
Filed: August 10, 1989
395/3

10/1/93
REM:mcw

[illegible]

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

PETITION UNDER 37 C.F.R. §3.81

Docket Number:
395/3-Application Number
07/392,073Filing Date
August
10,
1989Exam No.
C41Examiner
S. RosenArt Unit
1802Invention Title
METHOD OF SCREENING FOR
PROTEIN INHIBITORS AND
ACTIVATORSInventor(s)
HouseyAddress to:
Commissioner of Patents and Trademarks
Washington D.C. 20231

SIR:

Applicant hereby petitions the Commissioner of Patent and Trademarks to have the above-identified patent application issue to the Assignee, ICT Pharmaceuticals, Inc., 2170 Broadway, New York, New York 10024. ICT Pharmaceuticals, Inc. is a corporation of the State of Delaware. The Assignment and the Assignment Form Recordation Sheet are being submitted herewith for recordation.

The issue fee was paid, and the patent will issue on November 30, 1993.

Please charge the 37 C.F.R. §1.17(i)(1) fee of \$130.00 to Deposit Account No. 11-0600. A copy of this Petition is enclosed for this purpose.

(TUE) 7.11.00 14:18/ST. 14:12/NO. 4861472 P 16

Favorable consideration of this Petition is respectfully requested.

Dated: 1 October 1993

By: 
Kenneth E. Madsen (Reg. No. 20,721)

KENYON & KENYON
One Broadway
New York, N.Y. 10004
(212) 425-7200 (telephone)
(212) 425-5288 (facsimile)

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RCM

TUE 7.11'00 14:16/ST. 14:12/NO. 486147477 P 12



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

Ldb/kdb

Paper No. 25

Kenneth E. Madsen
Kenyon & Kenyon
One Broadway
New York, N.Y. 10004

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OCT 15 1993

OFFICE OF PETITIONS
A/C PATENTS

In re Application of
Gerard Housley
Serial No. 07/392,073
Filed: August 10, 1989
Attorney Docket No. 3690PCUS2

ON PETITION

This is a decision on the petition under 37 CFR 3.81, filed October 6, 1993, for issuance of patent to assignee on a late assignment.

The petition is granted.

The assignment has been forwarded to the Assignment Branch to be processed.

The requested data will be printed on the patent if this can be accomplished without substantial disruption to the issue process. However, if the printing of the patent has progressed to the point where the requested data cannot be included in the printed patent, petitioner can request a Certificate of Correction.

The application is being forwarded to the Publishing Division to be processed into a patent.

Karen D. Babington

Karen D. Babington
Office of Petitions
Office of the Assistant Commissioner
for Patents

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